

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Thomas M. Collins et al.	Art Unit :	2155
Serial No. :	09/855,584	Examiner :	Alicia Baturay
Filed :	May 16, 2001	Conf. No. :	1405
Title :	METHOD AND APPARATUS FOR DISTRIBUTING OF E-MAIL TO MULTIPLE RECIPIENTS		

**Mail Stop Appeal Brief - Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REPLY BRIEF

Pursuant to 37 C.F.R. § 41.41, Applicant responds to the Examiner's Answer as follows.

**1. Claims 6, 17, 23, 29, 40-42, 44-46, 48-50, 52-55, 57-60, 62-65 and 67-70 are patentable over the combination of Foladare, Redpath, and Beck**

A. Applicant respectfully disagrees with the Examiner's Answer, which states (at page 12) that "there is nothing specific in the claim language that limits the independent claims to an interpretation of 'a control mechanism that provides for the recipient-side to affect processes at the sender-side.'" The Examiner's Answer goes on to argue, incorrectly, that the claim language does not make it clear that:

the sender-side should be removing any attachments, and could be interpreted the way Appellant has characterized Foladare [*sic*] on page 8 in the Brief ("the centralized electronic mail device acts after the e-mail was previously sent by the user device, i.e., transmitted from the user device to the centralized electronic mail device").

As explained below, Applicant respectfully disagrees with the Examiner's position that the claim language does not require that the reception profile—created and edited by a recipient—impact the transmission process at the sender-side. Independent claim 6, for example, makes it clear that a message "is transmitted from the sender without the attachment to any recipient whose

reception profile specifies not to receive an attachment, regardless of whether the sender designated the recipient to receive the message with or without the attachment”:

6. An article comprising a machine-readable medium storing machine-readable instructions that, when executed by the machine, cause the machine to perform the following operations:

\* \* \*

enable a *recipient* to create and edit a reception profile, the profile including the recipient's preferences with regard to receipt of prospective attachments; and

transmit the message over a network from the sender to the plurality of recipients, wherein the message is *transmitted from the sender without the attachment* to any recipient whose reception profile specifies not to receive an attachment, regardless of whether the sender designated the recipient to receive the message with or without the attachment, and

\* \* \*

Thus, claim 6 (as well as the other independent claims) makes it readily clear that the reception profile—created and edited by a recipient—impacts the transmission process at the sender-side. As recited in claim 6, if the recipient's reception profile specifies not to receive an attachment, then the message is transmitted from the sender without the attachment, regardless of whether the sender designated the recipient to receive the message with or without the attachment.

In contrast, Foladare discloses a centralized electronic mail device 160, which distributes an electronic mail (e-mail) message to a variety of electronic mail receiving devices 120-150 according to a profile database 165 after receiving the e-mail transmitted from a user device 100. Thus, according to Foladare, the user device 100 first transmits the e-mail message to the centralized electronic mail device 160, which then handles the distribution of the previously transmitted e-mail (*i.e.*, the centralized electronic mail device 160 acts after the e-mail is transmitted from the user device 100). The information in the profile database 165, which is used by the centralized electronic mail device 160 to determine how to distribute the e-mail message, does not impact or control what is transmitted from the user device 100. Thus, in

Foladare's system, the information in the profile database 165 does not impact or control what is transmitted from the sender-side.

**B.** Applicant respectfully disagrees with the Examiner's Answer, which relies (at page 13) on the Supreme Court's *KSR* decision as supporting the rationale that in the present case "all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions."

In particular, applicant disagrees with the conclusion that "all the component parts of the claim were known in Foladare, Redpath and Beck." For example, as explained at page 7 of the Appeal Brief, the cited references do not disclose or render obvious any mechanism that provides for the recipient-side to affect processes at the sender-side, such as whether an e-mail should be transmitted from the sender-side with, or without, an attachment. The cited references disclose attachment-related processes that take place exclusively on the recipient-side (*i.e.*, Foladare) or exclusively on the sender-side (*i.e.*, Redpath and Beck). Foladare allows only for the recipient-side to control the recipient-side decisions, and Redpath and Beck allow only for the sender-side to control the sender-side decisions.

Applicant also disagrees with the Examiner's conclusion that one skilled in the art could have combined the elements disclosed by the cited references by known methods "with no change in their respective functions" to obtain the claimed subject matter. Even if the references were somehow combined as suggested by the Examiner, that would not have resulted in, or rendered obvious, the claimed subject matter. For example, the Examiner's Answer argues (at page 5) that it would have been obvious to modify Foladare in view of Redpath to enable "the sender designating a recipient to receive the message without the attachment." However, even in such a combined system, the decision regarding whether to transmit an email message with or without an attachment would still be controlled by the sender's side only. At the recipient's side, Foladare's centralized electronic mail device 160 simply would decide, based on information in the profile database 165, whether an email message previously transmitted by the sender with an attachment should be delivered with (or without) the attachment to the various email receiving devices.

The Examiner's Answer further argues (at page 6), incorrectly, that it would have been obvious to modify the combination of Foladare and Redpath in view of Beck to enable "transmission of the message from the sender without the attachment." However, according to both Redpath and Beck, replacement of the attachment (either with an icon (Redpath) or an attachment reference (Beck)) is based solely on activity on the sender's side. Thus, neither Redpath nor Beck discloses that transmission of an attachment from the sender to a recipient is impacted by a reception profile created by a recipient, as recited in the pending claims. At most, a system based on the combined disclosures of Foladare, Redpath and Beck would replace an attachment either with an "attachment icon" (as in Redpath) or with an "attachment reference" (as in Beck). Replacement of any attachment would be initiated based solely on the sender's side independently of any action at the recipient's side.

Therefore, even if the disclosures of the references somehow were combined, there would have been no reason to modify the one-sided features of the cited references into features that control the transmission process at the sender-side from the recipient-side.

**2. Claims 43, 47, 51, 56, 61, 66 and 71 are patentable over the combination of Foladare, Redpath, Beck and Ulrich**

Applicant respectfully disagrees with the Examiner's Answer, which argues (at page 17) that Ulrich discloses enabling a user to create and edit a profile that specifies the recipient is not to receive attachments during a particular time frame, as recited, for example, in claim 43. In particular, the Examiner's Answer points to the following disclosure in Ulrich (col. 12, lines 33-37):

Therefore, the present invention allows the user of mobile device 3 to either select a parameter in the user profile to automatically send all attachments, only some or none. If none are to be sent automatically, the user can select only those attachments which are desired.

The Examiner's Answer then argues that "if the 'none' option is chosen, then no attachments

will be downloaded at the next [synchronization], which is functionally equivalent to the recipient not receiving attachments during a particular time frame.” That is incorrect for several reasons.

First, claim 43 recites that the recipient can create and edit a profile that “*specifies the recipient is not to receive attachments during a particular time frame.*” In contrast, according to Ulrich, even if the user of the device 3 selects to have none of the attachments sent automatically, the user profile fails to specify a “particular time frame” during which attachments will not be sent automatically. Instead, attachments will not be sent at *any* time (unless the user subsequently uses the add-file command discussed at col. 12, lines 57-64 and col. 13, lines 30-42). At most, Ulrich discloses that the add-file command can be used to specify when the user *does* want one or more attachments to be sent during the next synchronization. Ulrich does not, however, disclose or render obvious a profile that specifies the recipient is *not* to receive attachments “*during a particular time frame,*” as recited in claim 43 and other claims.

Furthermore, the Examiner’s Answer improperly refers to “functionally equivalent” as being the standard under 35 U.S.C. §103(a). Functional equivalency is not the proper standard for obviousness under section 103.

### Conclusion

For these reasons, and the reasons stated in the Appeal Brief, Applicant submits that the final rejections should be reversed.

A Request for Oral Hearing is being submitted separately.

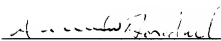
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Respectfully submitted,

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